

O-437-14

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF

APPLICATION NOS 2561044, 2598547 & 2598445

BY COMMUNITY CIRCLES HOLDINGS LIMITED

TO REGISTER THE FOLLOWING THREE TRADE MARKS IN CLASSES 16, 35,  
37, 39, 41 & 45:

**SOUTHWARK CIRCLE**

&

**SUFFOLK CIRCLE**

&

**HAMMERSMITH & FULHAM  
CIRCLE**

AND

OPPOSITION THERETO (UNDER NOS 102766, 103232, 102983)  
BY CIRCLE ANGLIA LTD

## **BACKGROUND**

1) Community Circles Holdings Limited ('the applicant') applied to register the following three trade marks (the filing date of the first mark is 11 October 2010; the filing date of the second and third marks is 19 October 2011):

**Application No 2561044 ('044'):**

### **SOUTHWARK CIRCLE**

**Application No 2598547 ('547'):**

### **SUFFOLK CIRCLE**

**Application No 2598445 ('445'):**

### **HAMMERSMITH & FULHAM CIRCLE**

2) All three trade mark applications have been made in respect of the same goods and services, as set out below:

**Class 16:** *Magazines; leaflets; printed publications; newsletters; information leaflets and books; periodical publications; except those relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings or the provision of accommodation.*

**Class 35:** *Providing business information with regard to tradesmen, care workers, domestic cleaners, gardeners and home helps; providing a referral system in which customers and tradesmen, care workers, domestic cleaners, gardeners, home helps and providers of other services to elderly people are introduced to each other.*

**Class 37:** *Installation, maintenance and repair of computer hardware; painting and decorating; cleaning, repair and maintenance services; repair of domestic electrical apparatus; advisory services into the maintenance and repair of domestic goods and domestic homes.*

**Class 39:** *Travel arrangement; travel information; advisory and information services relating to all the aforesaid services.*

**Class 41:** *The provision of online electronic publications; education activities and instruction relating to the well-being of older people; social club services; organisation of social events; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.*

**Class 45:** *Online social networking services for the purposes of social welfare; babysitting services; pet sitting services; domiciliary care services; domiciliary care services particularly for older people; domiciliary care services in the nature of night sitting; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.*

3) The trade marks were published in the Trade Marks Journal on 16 September 2011, 20 January 2012 and 11 November 2011 respectively and notice of opposition was subsequently filed against all three by Circle Anglia Ltd ('the opponent'). The opponent claims that the applications offend under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). All three oppositions are directed against all of the applicant's goods and services.

4) The opponent relies on three UK trade mark registrations, as shown in the table below:

Mark details	Goods and services relied upon
<p><b>UK trade mark: 2541795</b></p> <p><b>CIRCLE</b></p> <p><b>Filing date: 12 March 2010</b>  <b>Date of entry in the register: 07 January 2011</b></p>	<p><b>Class 16:</b> <i>Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; catalogues; brochures; newsletters; leaflets; promotional publications; all the aforesaid relating to the provision of accommodation.</i></p> <p><b>Class 35:</b> <i>Advertising; business management; business administration; office functions; compilation of statistics; compilation of information into computer databases; all the aforesaid relating to the provision of accommodation; business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 36:</b> <i>Insurance; financial affairs; monetary affairs; real estate affairs; real estate agency services; real estate management; housing agency services; provision of housing accommodation; letting agency for sheltered accommodation; management of housing; arranging of shared ownership of real estate; apartment house management; renting of houses, apartments and flats; information, advisory and consultancy services relating to all the aforesaid.</i></p>

**Class 37:** Building, construction; repair; installation services; real estate development; housing development; property development and maintenance; information, advisory and consultancy services relating to all the aforesaid.

**Class 41:** Education; providing of training; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and training workshops; providing on-line electronic publications (non downloadable); information, advisory and consultancy services relating to all the aforesaid; all the aforesaid services relating to the provision of accommodation; none of the aforesaid services relating to the healthcare, medical and surgical fields.

**Class 43:** Temporary accommodation services; rental of temporary accommodation; retirement home services; information, advisory and consultancy services relating to all the aforesaid.

**Class 45:** Legal services; personal and social services rendered by others to meet the needs of individuals; social work services; arbitration services; legal support services; all the aforesaid relating to the provision of accommodation; legal services relating to statutory powers dealing with unfit housing; security services for the protection of property and individuals; legal services relating to the purchase and sale of property; legal services relating to real estate; conveyancing services; information and consultancy services relating to health and safety; information, advisory and consultancy services relating to all the all of the aforesaid.

**UK trade mark: 2541793**



**Filing date: 12 March 2010**  
**Date of entry in the register: 19**  
**November 2010**


**Class 16:** Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; catalogues; brochures; newsletters; leaflets; promotional publications; all the aforesaid relating to the provision of accommodation.

**Class 35:** Advertising; business management; business administration; office functions; compilation of statistics; compilation of information into computer databases; all the aforesaid relating to the provision of accommodation; business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid.

**Class 36:** Insurance; financial affairs; monetary affairs; real estate affairs; real estate agency services; real estate management; housing agency services; provision of housing accommodation; letting agency for sheltered accommodation; management of housing; arranging of shared ownership of real estate; apartment house management; renting of houses, apartments and flats; information, advisory and consultancy services relating to all the aforesaid.

**Class 37:** Building, construction; repair; installation services; real estate development; housing development; property development and maintenance; information, advisory and consultancy services relating to all the aforesaid.

**Class 41:** Education; providing of training; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and training workshops; providing on-line electronic publications (not downloadable); information, advisory and consultancy services relating to all the aforesaid; all the aforesaid services relating to the provision of accommodation; none of the

	<p><i>aforesaid services relating to the healthcare, medical and surgical fields.</i></p> <p><b>Class 43:</b> <i>Temporary accommodation services; rental of temporary accommodation; retirement home services; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 45:</b> <i>Legal services; social work services; arbitration services; legal support services; all the aforesaid relating to the provision of accommodation; legal services relating to statutory powers dealing with unfit housing; security services for the protection of property and individuals; legal services relating to the purchase and sale of property; legal services relating to real estate; conveyancing services; information and consultancy services relating to health and safety; information, advisory and consultancy services relating to all the aforesaid.</i></p>
<p><b>UK trade mark: 2541794</b></p>  <p><b>Filing date: 12 March 2010</b>  <b>Date of entry in the register: 01 October 2010</b></p>	<p><b>Class 16:</b> <i>Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; catalogues; brochures; newsletters; leaflets; promotional publications.</i></p> <p><b>Class 35:</b> <i>Advertising; business management; business administration; office functions; compilation of statistics; compilation of information into computer databases; business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 36:</b> <i>Insurance; financial affairs; monetary affairs; real estate affairs; real estate agency services; real estate management; housing agency services; provision of housing accommodation; letting agency for sheltered accommodation; management of</i></p>

	<p><i>housing; arranging of shared ownership of real estate; apartment house management; renting of houses, apartments and flats; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 37:</b> <i>Building, construction; repair; installation services; real estate development; housing development; property development and maintenance; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 41:</b> <i>Education; providing of training, entertainment; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and training workshops; providing on-line electronic publications (not downloadable); information, advisory and consultancy services relating to all the aforesaid; none of the aforesaid services relating to the healthcare, medical and surgical fields.</i></p> <p><b>Class 43:</b> <i>Temporary accommodation services; rental of temporary accommodation; retirement home services; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 45:</b> <i>Legal services; security services for the protection of property and individuals; social work services; arbitration services; legal services relating to statutory powers dealing with unfit housing; legal support services; legal services relating to the purchase and sale of property; legal services relating to real estate; conveyancing services; information and consultancy services relating to health and safety; information, advisory and consultancy services relating to all the aforesaid.</i></p>
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5) All of the marks relied upon by the opponent have a filing date of 12 March 2010. Further, their registration procedures were completed on 07 January 2011, 19

November 2010 and 01 October 2010. The consequences of these dates, in relation to the applicant's marks, are that i) the opponent's marks are earlier marks in accordance with section 6 of the Act; and ii) they are not subject to the proof of use conditions contained in section 6A of the Act.

6) The applicant filed a separate counterstatement for each opposition, denying the grounds of opposition.

7) Further to receipt of the counterstatements (after an extended cooling-off period) the three oppositions were consolidated<sup>1</sup> in light of the identity of the parties and the similar issues to be determined. Neither party filed evidence. Both parties opted to file written submissions in lieu of attendance at a hearing. I now make this decision after conducting a thorough review of the papers and giving full consideration to all submissions. I will refer to certain of the parties' submissions as, and when, I consider it appropriate in the decision which follows.

## **DECISION**

### **Section 5(2)(b)**

8) This section of the Act provides:

“5. (2) A trade mark shall not be registered if because –

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

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<sup>1</sup> Under the provision of rule 62(1)(g) of The Trade Marks Rules 2008.



chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

10) In its written submissions in lieu of a hearing the opponent states:

“The Opponent acknowledges that the strongest argument against registration of the Applicant Marks arises under section 5(2)(b) of the Act on the basis of its UK Registration No. 2541795 for the word mark CIRCLE in Classes 16, 35, 36, 37, 41, 43 and 45.”

11) I agree. I will make the comparison on the basis of that earlier registration. In my view, the opponent has no stronger prospect of success in relation to its other earlier registrations.

## Comparison of goods and services

12) The goods and services to be compared are shown in the table below:

<b>Opponent's goods and services</b>	<b>Applicant's goods and services</b>
<p><i>Class 16: Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; books; catalogues; brochures; newsletters; leaflets; promotional publications; all the aforesaid relating to the provision of accommodation.</i></p> <p><i>Class 35: Advertising; business management; business administration; office functions; compilation of statistics; compilation of information into computer databases; all the aforesaid relating to the provision of accommodation; business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><i>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; real estate agency services; real estate management; housing agency services; provision of housing accommodation; letting agency for sheltered accommodation; management of housing; arranging of shared ownership of real estate; apartment house management; renting of houses, apartments and flats; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><i>Class 37: Building, construction; repair; installation services; real estate development; housing development; property development and maintenance; information, advisory and consultancy services relating to all the aforesaid.</i></p> <p><i>Class 41: Education; providing of training; arranging and conducting of colloquiums, conferences, congresses,</i></p>	<p><i>Class 16: Magazines; leaflets; printed publications; newsletters; information leaflets and books; periodical publications; except those relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings or the provision of accommodation.</i></p> <p><i>Class 35: Providing business information with regard to tradesmen, care workers, domestic cleaners, gardeners and home helps; providing a referral system in which customers and tradesmen, care workers, domestic cleaners, gardeners, home helps and providers of other services to elderly people are introduced to each other.</i></p> <p><i>Class 37: Installation, maintenance and repair of computer hardware; painting and decorating; cleaning, repair and maintenance services; repair of domestic electrical apparatus; advisory services into the maintenance and repair of domestic goods and domestic homes.</i></p> <p><i>Class 39: Travel arrangement; travel information; advisory and information services relating to all the aforesaid services.</i></p> <p><i>Class 41: The provision of online electronic publications; education activities and instruction relating to the well-being of older people; social club services; organisation of social events; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.</i></p> <p><i>Class 45: Online social networking services for the purposes of social welfare;</i></p>

*seminars, symposiums and training workshops; providing on-line electronic publications (non downloadable); information, advisory and consultancy services relating to all the aforesaid; all the aforesaid services relating to the provision of accommodation; none of the aforesaid services relating to the healthcare, medical and surgical fields.*

*Class 43: Temporary accommodation services; rental of temporary accommodation; retirement home services; information, advisory and consultancy services relating to all the aforesaid.*

*Class 45: Legal services; personal and social services rendered by others to meet the needs of individuals; social work services; arbitration services; legal support services; all the aforesaid relating to the provision of accommodation; legal services relating to statutory powers dealing with unfit housing; security services for the protection of property and individuals; legal services relating to the purchase and sale of property; legal services relating to real estate; conveyancing services; information and consultancy services relating to health and safety; information, advisory and consultancy services relating to all the all of the aforesaid.*

*babysitting services; pet sitting services; domiciliary care services; domiciliary care services particularly for older people; domiciliary care services in the nature of night sitting; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.*

13) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

14) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('*Beautimatic*') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given 'an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor'. However, I must also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* ('*Avnet*') [1998] FSR 16:

'In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.'

15) Further, in *YouView TV Ltd v Total Ltd* ('*YouView*') [2012] EWHC 3158 (Ch) at [12] Floyd J said:

'... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.'

16) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Boston')* Case T- 325/06 it was stated:

'It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03

Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).

On the matter of complementarity, I also bear in mind the comments of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13.

17) When comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Meric')* Case T-133/05).

18) Finally, I also bear in mind that, where it is not obvious to me that there is similarity between respective goods and services, the onus is on the opponent to present evidence (or at least focused submissions) in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

19) I will make the comparison by addressing the services covered by the applications in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10).

### Class 16

20) *'Magazines; leaflets; printed publications; newsletters; information leaflets and books; periodical publications; except those relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings or the provision of accommodation.'*

The opponent submits that all of the applicant's goods are encompassed by its '*printed matter*' and '*printed publications; books; catalogues; brochures; newsletters; leaflets; promotional publications*'. However, as the applicant points out, the opponent's goods are limited to those relating to the provision of accommodation. The respective goods cannot therefore be considered identical since the applicant's specification excludes goods relating to the provision of accommodation. Nevertheless, whilst the exclusion in the applicant's specification avoids identity between the respective goods (since the exact subject matter is not the same), it does not, in my view, exclude similarity between them. Regardless of respective subject matter, there remains, in any event, identity in physical nature (all being printed publications of various kinds) and the trade channels may be the same since publications on a wide variety of topics may be sold through the same retail establishments. I find there to be a reasonable degree of similarity between the respective goods.

### Class 35

21) *'Providing business information with regard to tradesmen, domestic cleaners, gardeners; providing a referral system in which customers and tradesmen, domestic cleaners, gardeners and providers of other services to elderly people are introduced to each other.'*

The opponent submits that the applicant's services listed above fall within its *'business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid'* and are therefore identical. The applicant disputes that any identity or similarity exists. I think it reasonable to conclude that the opponent's services are likely to involve ensuring that real estate is maintained and repaired. It appears obvious that that will necessarily entail arranging for various professionals to carry out that maintenance/repair on the property or providing information/advice to the owner of the property about such professionals (such as cleaners, gardeners and other tradespeople) and arranging introductions between the same. Accordingly, I consider the respective services to be reasonably similar.

22) *'Providing business information with regard to care workers and home helps; providing a referral system in which customers and care workers and home helps to elderly people are introduced to each other.'*

The opponent also contends that the applicant's services listed above would fall within its *'business management of real estate for others; information, advisory and consultancy services relating to all the aforesaid'* or be highly similar. I disagree. The core purpose of care workers and home helps is to provide care to people and to assist those people in carrying out daily tasks around the home, it is not their primary purpose to care for, maintain or manage real estate. I therefore fail to see why the opponent's management of real estate would involve or be similar to providing information about, or referring individuals to, care workers and home helps. There is no similarity between these respective services. Nevertheless, I note that the opponent's specification covers *'retirement home services'*. These are services provided primarily to elderly people. Whilst they mainly involve the provision of accommodation, some retirement homes are also likely, in my view, to provide a certain degree of care and assistance to its elderly residents. This may necessarily involve providing information about care workers and home helps and introducing customers to the same. I consider there to be a fair degree of similarity between the respective services.

### Class 37

23) *'painting and decorating; cleaning, repair and maintenance services; advisory services into the maintenance and repair of domestic homes.'*

The opponent submits that the applicant's services listed above fall within the terms listed in its class 37 specification. The opponent's services include *'property development and maintenance'* and *'information, advisory and consultancy services'* relating to the same. The applicant's services would be encompassed by the opponent's aforementioned services. They are identical in accordance with *Meric*.

24) *'Installation, maintenance and repair of computer hardware; repair of domestic electrical apparatus; advisory services into the maintenance and repair of domestic goods.'*

Turning to the applicant's services listed above, again the opponent contends that these are encompassed by its class 37 services. I can see no similarity between the applicant's services and the opponent's *'Building, construction; real estate development; housing development; property development and maintenance; information, advisory and consultancy services relating to all the aforesaid.'* This leaves the opponent's *'repair'* and *'installation'* services (and *'information, advisory and consultancy services'* relating to the same). In relation to these terms, the applicant states that they "are not sufficiently clear and precise for registration purposes following the decision of the Court of Justice of the European Union in Case C-307/10 *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* (IP TRANSLATOR)." and that they "are too vague and must, therefore, be discounted." I note that in 'PAN 03/13 Lists of goods/services and the use of Class headings' the relevant terms have been deemed to lack clarity and precision. I agree with the applicant that these terms are so vague such as to prevent me from being able to conduct a legitimate comparison between the respective services. I find support for such an approach in the decision of the General Court in *Advance Magazine Publishers, Inc. v OHIM*, T-229/12, paragraph [28] - [42]. Accordingly, I am unable to find identity or similarity between the respective services.

#### Class 39

25) *'Travel arrangement; travel information; advisory and information services relating to all the aforesaid services.'*

In relation to the applicant's class 39 services, the opponent submits:

"we submit that such services are similar or at the very least complimentary to other services for which the Opponent enjoys prior rights including "temporary accommodation services...retirement home services...", "arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and training workshops" and "...social work services...". The provision of such services necessitates related travel arrangement services which are covered by the Applicant Marks."

I am far from persuaded by this submission. Bearing in mind the guidance in *Avnet* and *Boston*, I cannot see any meaningful similarity between the respective services. The respective nature and intended purpose is entirely different and they are certainly not in competition or complementary "in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

#### Class 41

26) *'The provision of online electronic publications; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations,*

*horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.'*

The applicant's services listed above are not identical to the opponent's *'providing on-line electronic publications (non downloadable); all the aforesaid services relating to the provision of accommodation'* because of the respective exclusion and limitation. Nevertheless, given that the nature of the respective services is the same, as they both involve providing online publications, and that publications on a variety of topics may be provided through the same trade channels, I find there to be a reasonable degree of similarity.

27) *'education activities and instruction relating to the well-being of older people; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.'*

The opponent's strongest case against the applicant's services listed above lies with its *'education; ...all the aforesaid services relating to the provision of accommodation'*. Both parties' services involve education and are therefore similar in nature, however, the subject matter of that education is not the same. It is not obvious to me that the trade channels would overlap to any significant extent between education services relating to the well-being of older people (which I understand to mean the general health and happiness of older people) and education relating to the provision of accommodation. To my mind, the overall similarity between the respective services is low.

28) *'social club services; organisation of social events; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.'*

I can see no meaningful similarity between the applicant's services listed above with any of the opponent's goods and services.

#### Class 45

29) *'Online social networking services for the purposes of social welfare; babysitting services; pet sitting services; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.'*

The opponent's strongest case against the services listed above appears to lie with its *'personal and social services rendered by others to meet the needs of individuals; social work services....all the aforesaid relating to the provision of accommodation'*. However, I can see no obvious similarity within the parameters of the case law between the respective services.

30) *'domiciliary care services; domiciliary care services particularly for older people; domiciliary care services in the nature of night sitting; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.'*



The opponent submits that the applicant's various domiciliary care services are complementary and similar to its '*retirement home services*'. As I have already stated earlier in this decision, it appears to me that a certain degree of care and assistance is likely to be provided by some retirement homes to its residents. Accordingly, there is a degree of complementarity. There also appears to be a degree of competition between the services since a consumer may choose between moving to a retirement home or having care workers visit them in their current home. The intended purpose of the respective services also overlaps to a degree since both are likely to involve providing assistance to elderly people in their day to day lives. I consider there to be a reasonably good degree of similarity overall between the relevant respective services and I cannot see how the applicant's exclusion '*none of the aforesaid services relating to the provision of accommodation*' logically disturbs this conclusion.

### **Average consumer and the purchasing process**

31) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods and services.

32) The respective specifications cover a range of goods and services. The average consumer, for the most part, is the general public and, for certain of the goods and services, elderly members of the public. However, for services such as 'business management of real estate for others', I would expect the average consumer to also include businesses. The level of attention paid by the average consumer is likely to vary from fairly low in relation to goods such as '*magazines*' up to at least reasonably good in relation to services such as those in the parties' class 35 specifications. I would expect all of the goods and services to be sought out primarily by eye, but aural considerations are not discounted.

### **Comparison of marks**

33) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). Accordingly, there cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components.

Opponent's mark	Applicant's marks
<p><b>CIRCLE</b></p>	<p><b>044:</b></p> <p style="text-align: center;"><b>SOUTHWARK CIRCLE</b></p> <p><b>547:</b></p> <p style="text-align: center;"><b>SUFFOLK CIRCLE</b></p> <p><b>445:</b></p> <p style="text-align: center;"><b>HAMMERSMITH &amp; FULHAM CIRCLE</b></p>

34) The opponent's mark consists of a single component - the word 'CIRCLE', presented in plain block capitals. The distinctiveness lies in the mark as a whole.

35) The words in the applicant's marks are also presented in plain block capitals and appear to hang together in each mark. That said, bearing in mind that the words 'SOUTHWARK', 'SUFFOLK', 'HAMMERSMITH & FULHAM' are likely to be perceived as mere geographical indications as to the source of the goods or services, it is the word CIRCLE which is likely to attract a greater degree of attention in each mark.

36) The presence of the geographical place names and the '&' symbol in the applicant's marks, which are absent from the opponent's mark, creates some visual and aural contrast. Nevertheless, the fact that all of the respective marks coincide in respect of the word CIRCLE still results, in my view, in a degree of visual and aural similarity. I would put the degree of aural and visual similarity between the opponent's mark and marks 044 and 547 at reasonable. Insofar as the applicant's mark 445 is concerned, I would put the level lower, at moderate. In relation to the conceptual aspect, I note that the applicant submits:

"The word "CIRCLE" in the applied for mark implies a group such as "a circle of friends". The marks are therefore quite distinct in meaning..."

37) I am not persuaded that the marks are "quite distinct" in meaning. Regardless of exactly how the word CIRCLE is perceived in the applicant's marks, whether as the

well-known geometric shape or a group of people (based in Southwark, Suffolk or Hammersmith & Fulham), such possible perceptions of the word CIRCLE are equally applicable to the opponent's mark. Bearing this in mind, I find there to be a reasonably good degree of conceptual similarity between the opponent's mark and all of the applicant's marks.

### **Distinctive character of the earlier mark**

38) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

39) The opponent states that it has been using its 'CIRCLE' mark since 1968 with the result that it has built a high level of reputation. However, in the absence of any evidence to corroborate this assertion, I can only take into account the mark's inherent level of distinctiveness.

40) In its counterstatements the applicant states:

“...it should be borne in mind that the word “CIRCLE”, on its own, is inherently low in distinctiveness.

41) The word “CIRCLE”, as I have already indicated, may be perceived as describing the well known geometric shape or perhaps a group of people. Either way, the mark is not particularly distinctive. I find the mark to have no more than a moderate degree of distinctive character.

### **Likelihood of confusion**

42) In deciding whether there is a likelihood of confusion I must take account of all of my earlier findings. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

43) At this point, I remind myself that there cannot not be a likelihood of confusion where there is no similarity between the respective goods and services. Accordingly, the opposition must fail in relation to the applicant's services which I have found

share no similarity with any of the opponent's goods and services (*Waterford Wedgwood plc v OHIM – C-398/07 P*).

44) As for the remaining goods and services covered by the applications, I have found these to be either identical or similar (to varying degrees) to the opponent's goods and services. The relevant average consumer includes the general public, elderly members of the public and businesses. The level of attention will vary from fairly low to at least reasonably good during the mainly visual purchasing act. I have also found that the earlier mark is possessed of no more than a moderate degree of inherent distinctive character. As regards the similarities between the respective marks, I have found that the degree of aural and visual similarity between the opponent's mark and marks 044 and 547 is reasonable. Insofar as the applicant's mark 445 is concerned the level of aural and visual similarity is moderate. On a conceptual level, there is a reasonably good degree of similarity between the opponent's mark and all of the applicant's marks.

45) Drawing all of my findings together, I find that where the level of similarity between the respective services is low, I think it unlikely that the average consumer would be confused. However, where I have found that the respective goods and services are either identical, fairly similar, reasonably similar or similar to a reasonably good degree, this, combined with the similarities between the marks, results, in my judgment, in a likelihood of confusion.

#### **Summary:**

46) The opposition fails in relation to the following services in each application:

**Class 37:** *Installation, maintenance and repair of computer hardware; repair of domestic electrical apparatus; advisory services into the maintenance and repair of domestic goods.*

**Class 39:** *Travel arrangement; travel information; advisory and information services relating to all the aforesaid services.*

**Class 41:** *Education activities and instruction relating to the well-being of older people; social club services; organisation of social events; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.*

**Class 45:** *Online social networking services for the purposes of social welfare; babysitting services; pet sitting services; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.*

47) The opposition succeeds in relation to the following goods and services in each application:

**Class 16:** Magazines; leaflets; printed publications; newsletters; information leaflets and books; periodical publications; except those relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings or the provision of accommodation.

**Class 35:** Providing business information with regard to tradesmen, care workers, domestic cleaners, gardeners and home helps; providing a referral system in which customers and tradesmen, care workers, domestic cleaners, gardeners, home helps and providers of other services to elderly people are introduced to each other.

**Class 37:** Painting and decorating; cleaning, repair and maintenance services; advisory services into the maintenance and repair of domestic homes.

**Class 41:** The provision of online electronic publications; none of the above relating to personal appearance, life coaching, fortune telling, astrology consultations, horoscopes, tarot and card readings; none of the aforesaid services relating to the provision of accommodation.

**Class 45:** Domiciliary care services; domiciliary care services particularly for older people; domiciliary care services in the nature of night sitting; advisory services in relation to the foregoing; none of the aforesaid services relating to the provision of accommodation.

## **COSTS**

48) Given the reasonable proportion of success enjoyed by each party, I do not propose to favour either side with an award of costs.

**Dated this 9th day of October 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**